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REMARKS

Claims 1- 2 and 4-14 are pending and under consideration. Reconsideration is requested.

Claims 1-2 and 4-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chang (US 6,584,459). The rejections are traversed.

Independent claim 1 recites a managing apparatus for managing a document including transaction slip data used in electronic commerce with a database device including:

a) "a data extracting unit extracting structure data as a search item of the document including transaction slip data therefrom;"

b) "a storing unit storing the structure data extracted by said data extracting unit as management data that is correlated with the transaction slip data;"

c) "a transaction slip data extracting unit searching the management data so as to extract the transaction slip data that is correlated with management data;"

d) "a transmitting unit transmitting the transaction slip data extracted by said transaction slip data extracting unit;"

e) "a receiving unit receiving the transmitted transaction slip data; and

f) "a converting unit <u>converting a first format of the received transaction slip data into a second format based on a transmission destination</u> (emphasis added),"

g) "wherein the first format <u>of the received</u> transaction slip data is <u>useable by an order issuer</u> and the second format <u>based on a transmission destination</u> is <u>useable by an order acceptor</u> in an electronic business transaction <u>between the order issuer and the order acceptor without requiring a tailoring of servers</u> of the <u>order issuer</u> and the <u>order acceptor</u>." (emphasis added)." Independent claims 6, 7, and 11 have similar recitations.

The Examiner concedes:

> Chang does not specifically disclose that the first format of the received transaction slip data is usable by an order issuer (buyer) and the second format based on a transmission destination is usable by an order acceptor (seller) in an electronic business transaction between the order issuer and order acceptor without requiring a tailoring of servers of the order issuer and the order acceptor.

(Office Action, page 5, lines 7 -11).

However, the Examiner asserts that:

> Chang discloses a relational facility that allows users to define new and distinct

data types and subtypes, according to user expectations. See, for example, at least Col. 7, lines 38-54.

(Office Action, page 5, lines 11-13).

The Examiner further asserts:

> it would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Chang to disclose . . . (recited feature not disclosed) . . . One of ordinary skill in the art at the time the invention was made would have been motivated to extend Chang to disclose . . . (recited feature not disclosed)... for the obvious reason that there is a need to manage an abundance of XML documents, and a need for a product that understands document structures and allows a user to store, search using structure queries and retrieve XML documents and their data within a database system. See, for example, Fig. 2, DB2 XML extender, which converts data to and from formats used by other systems and parties.

(emphasis added, Current Office Action, page 5, line 14 - page, 6, line 8).

Applicants point out as set forth in the USPTO Examination Guidelines for Determining Obviousness Under 35 U.S.C. §103 in View of the Supreme Court Decision in *KSR* International Co. v. Teleflex Inc. (*KSR*) effective October 10, 2007[Federal Register: October 10, 2007 (Volume 72, Number 195)][Notices][Page 57526-57535] :

> As reiterated by the Supreme Court in KSR, the framework for the objective analysis for determining obviousness under 35 U.S.C. §103 is stated in Graham v. John Deere Co. Obviousness is a question of law based on underlying factual inquiries. . . . (2) Ascertaining the differences between the claimed invention and the prior art; and (3) Resolving the level of ordinary skill in the pertinent art.

(See, Examination Guidelines, page 57527, col. 1).

The USPTO Guidelines indicate that

> the proper question is whether the ordinary artisan possesses knowledge and skills rendering him capable of combining the prior art references."

(See, Examination Guidelines, page 57534, col. 2).

The Federal Circuit in citing KSR indicated that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Ent., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1161, 1161, 82 USPQ2d 1687, 1690-91 (Fed. Cir. 2007) (citing *KSR*, 127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007).

Applicants respectfully submit that the Examiner erred in the Graham factual inquires in holding the modification of Chang as obvious and teaching recited features of claim 1, for example in whole.

By contrast, in the section cited by the Examiner, Chang discloses:

> The ADT 142 is a relational facility introduced by DB2.RTM. version 6 allowing the user to define new and distinct data types and subtypes to a database engine. Subsequently, the database engine ensures that an application uses data of a specific data type only when the user requires and expects such an action. In order to provide the flexibility of user defined types and subtypes, the XML extender 100 creates an ADT 142 called DB2XML for storing and retrieving XML documents. The DB2XML ADT 142 is a structured data type with its own attributes, which are used to store data and metadata of XML documents. With the DB2.RTM.version 6 ADT feature, a set of methods called accessor methods is automatically.generated when DB2XML ADT 142 is created. The implementation of the ADT 142 will be discussed below within the overall operation of the XML extender 100

(col. 7, lines 38-54).

Chang discloses that the extender (cited by the Examiner as "Fig. 2, DB2 XML extender, which converts data to and from formats used by other systems and parties.") is:

> As illustrated in FIG. 2, the extender 100 comprises a GUI tool 120, an extender core 140, an XML parser 160, and a search engine 180. The GUI tool 120 is a tool to generate a standard SQL application program interface (API) allowing the user to access and manipulate data. The GUI tool 120 further comprises standard functions for facilitating searches (Xsearcher) 124, for accessing an XML document after a search is completed, and retrieving search results (Xviewer) 122, as well as an administration tool 126. The extender core 140 includes an abstract data type (ADT) 142, user defined functions (UDFs) 144, an administration tool 146, and an indexing tool 148.

(Col. 7, lines 27 -37).

Applicants submit that the Examiner errs in that one of ordinary skill in the art could not have modified the claimed elements by known methods and that the recited elements do not merely perform the function that each element performs separately.

Even in view of *KSR* and the Examination Guidelines, to establish obviousness under §103, the Examiner must consider the claimed invention "as a whole," and the prior art must teach or suggest all of the claim features. *In re Royka*, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974); *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988); *Ruiz v. A.B. Chance Co.*, 69 U.S.P.Q.2d 1686, 1690 (Fed. Cir. 2004). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claim 1 recites a converting so a "first format of the received transaction slip data is useable by an order issuer . . . is useable by an order acceptor in an electronic business transaction between the order issuer and the order acceptor without requiring a tailoring of

server(s) of the order issuer . . . " and that also recites converting so a " second format based on a transmission destination is useable by an order acceptor in an electronic business transaction between the order issuer and the order acceptor without requiring a tailoring of server(s) of . . . . the order acceptor."

That is, claim 1 recites an apparatus in which conversions are carried out that are dependent on both the acceptor's sever and the issuer's server.

Further, claim 1 recites "transmitting the transaction slip data extracted over a network." The Examiner asserts this "transmitting" is disclosed by Chang Col. 6, line 17-line 45.

Applicants point out that Chang discloses:

> FIG. 7 illustrates an exemplary computer hardware environment for use with the present invention. In FIG. 7, a computer system 702 has one or more processors connected to one or more data storage devices 704 that store one or more relational databases. Each data storage device 704 may be any of a plurality of types, all of which are well known in the art, including but not limited to magnetic, optical, magneto-optical or semiconductor memory.
> (col. 6, lines 19 - 28).

That is, Chang does not disclose a conversion of data exchanged between different servers, but rather on interfaces within a computer. (see, Fig. 7).

Applicants submit that the *arguendo* converting methodology in Chang is directed toward interfaces within a computer system and not between servers. Accordingly, Applicants submit that the Examiner errs in that one of ordinary skill in the art would have modified Chang to convert between different and specified servers. In fact, Chang does not disclose the term "server."

Summary

Applicants submit that independent claims 1, 6-7, and 11 and respective dependent claims 2, 4-5, 8-10 and 12-14 patentably distinguishes over the prior art and that the Examiner has erred in filing to establish prima facie obviousness, and request the rejection be withdrawn and claims 1-2 and 12-14 allowed.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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